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**Datasheet for the decision
of 9 July 2008**

Case Number: T 1557/07 - 3.4.01

Application Number: 04775193.8

Publication Number: 1715919

IPC: A61N 5/06

Language of the proceedings: EN

Title of invention:

Medical apparatus with light flux for biological treatments

Applicants:

Degeratu D. Ion Cristian
Constantinescu V. Vladimir

Headword:

-

Relevant legal provisions:

-

Relevant legal provisions (EPC 1973):

EPC Art. 113(1), 111(1), 83
EPC R. 27(1), 67

Keyword:

"Basis of decision - opportunity to comment (yes)"
"Disclosure - sufficiency (yes)"
"Decision in support of appeals - remittal (yes)"

Decisions cited:

T 0734/91, T 0268/00, T 1019/99

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 1557/07 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 9 July 2008

Appellants:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 20 April 2007
refusing European application No. 04775193.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: B. Schachenmann
Members: G. Assi
F. Neumann

Summary of Facts and Submissions

I. The appellants (applicants) lodged an appeal, received on 15 June 2007, against the decision of the examining division, dispatched on 20 April 2007, refusing the European patent application No. 04775193.8 (publication number 1 715 919). The fee for the appeal was paid on 15 June 2007. The statement setting out the grounds of appeal was received on 30 August 2007.

In the contested decision, the examining division held that the application did not meet the requirements of Article 83 EPC 1973.

II. Oral proceedings before the Board took place on 9 July 2008.

III. During the oral proceedings the appellants requested that the case be remitted to the examining division due to a substantial procedural violation and that the appeal fee be reimbursed. Alternatively, the appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1-8 filed during the oral proceedings.

IV. The wording of claim 1 reads as follows:

"A medical apparatus for producing light flux for biologic treatments, the apparatus comprising: a case (1), a support (3) which bears a light source bulb (4), a concave mirror (6) set on an axial bar on one wall of the case (1), wherein on the opposite wall there is an optical filter (11) mounted on an objective (10) in an orifice of the case (1) and wherein a rotating shutter

disc (8) comprising orifices (c, d) is mounted on the same wall as the optical filter (11), characterised in that the rotating shutter disc (8) is equipped with a slit regulating device (9), and in that the orifices (c, d) become coaxial with the optical filter axis during rotation of the shutter disc (8), the light flux being made up of the rays reflected by the concave mirror (6) and of the direct rays emitted by the light source bulb (4), the rays passing through the orifices (c, d) of the rotating shutter disc (8) to the objective (10)."

Claims 2-8 are dependent claims.

- v. The revised version of the European Patent Convention or EPC 2000 entered into force on 13 December 2007. At that time, the present application was still pending. Pursuant to Article 7, paragraph 1, of the Act, dated 29 November 2000, revising the European Patent Convention of 5 October 1973 (Special Edition No. 1 OJ EPO, 196), the revised version of the Convention shall not apply to European patent applications pending on 13 December 2007, unless otherwise decided by the Administrative Council of the European Patent Organisation. With a decision of 28 June 2001 (Special Edition No. 1 OJ EPO 2007, 197), the Administrative Council decided on the transitional provisions under Article 7 of the said Act of 29 November 2000. With a further decision of 7 December 2006 (Special Edition No. 1 OJ EPO 2007, 89), the Administrative Council decided on the Implementing Regulations to the EPC 2000.

Therefore, in the present decision, reference will be made to "EPC 1973" or "EPC" for EPC 2000 (EPC, Citation practice, pages 4-6) depending on the version to be

applied according to the Revision Act and the decisions of the Administrative Council mentioned above.

Reasons for the Decision

1. The appeal is admissible.
2. *Request for remittal of the case due to a substantial procedural violation*
 - 2.1 In the present case, during the examination procedure the examining division raised an objection under Article 83 EPC 1973 in a first communication pursuant to Article 96, paragraph 2, EPC 1973, dated 20 November 2006. With a letter of 19 March 2007, the applicants submitted arguments against the raised objection and filed new application documents, in particular amended claims 1-4. The examining division then issued the decision under appeal refusing the application on the ground of Article 83 EPC 1973.
 - 2.2 The representative of the appellants submitted that the examining division, without having given any warning that the application might be refused, issued the decision under appeal although the letter of 19 March 2007 represented a "*bona fide attempt to overcome the objections raised*" and the amended claims filed with this letter created a significantly new factual situation. Under these circumstances, following T 734/91 (unpublished), Article 113, paragraph 1, EPC 1973 required the issue of a second communication dealing with the substantial comments of the applicants and the amended claims. Indeed, the appellants, two

private persons, had a fair expectation to receive a further communication. Moreover, the contested decision was deficient under two aspects. First, the arguments produced by the appellants "were not addressed fully nor accurately" by the examining division and, second, a statement was made "for the first time in the proceedings in the reasons for the refusal" in point 1.7 of the Reasons, last paragraph. All this amounted to a substantial procedural violation which justified the remittal of the case to the examining division for further prosecution and the reimbursement of the appeal fee.

- 2.3 It should be noted that, in the present case, the provisions of Article 113, paragraph 1, EPC 1973 are met to the extent that the decision of 20 April 2007 is based on the same ground (Article 83 EPC 1973) and evidence mentioned in the communication of 20 November 2006. Therefore, the question to be considered only concerns whether the examining division had an obligation to issue a second communication giving the appellants an opportunity to present further comments. The fact that the appellants as private persons had a fair expectation of a further communication is not relevant for the question at issue since they were represented by professional representatives before the EPO.

Pursuant to Article 94, paragraph 3, EPC 1973, if the examination reveals that the application does not meet the requirements of the EPC, the examining division shall invite the applicant, "as often as necessary", to file his observations. Thus, the examining division had a power of discretion to either send a second

communication or to issue a decision. Article 113, paragraph 1, EPC 1973, however, limits the exercise of this power by requiring that the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

- 2.4 With regard to the appellants' submissions, a first issue relates to the allegation that the contested decision relied on fresh arguments. In principle, the Board has no reason to depart from T 268/00 (unpublished), according to which the use of a fresh argument in a decision still based on grounds and evidence communicated beforehand is not precluded (page 13, first paragraph). Notwithstanding this, in the present case the examining division came to the conclusion that it was not convinced that a skilled person was actually able to achieve the intended effect of increased penetration depth of light by means of the variation of the size of the orifices of the rotating shutter disc (contested decision, Reasons, point 1.7, last paragraph). This statement is also mentioned in the communication of 20 November 2006 (point 2.5) on which the appellants have had an opportunity to present their comments, this opportunity having been taken with the reply of 19 March 2007 (page 2, third paragraph). Thus, the allegation at issue is not conclusive.
- 2.5 A further issue concerns the amended claims filed by the appellants. According to the examining division (decision under appeal, point I.8), "*Claim 1, as filed on 19 March 2007, was modified in order to bring it in the two part form with regard to D1 [WO-A-92/13597, note of the Board] and D2 [WO-A-03/015868, note of the*

Board] and furthermore was grammatically reformulated. However, the new claim 1 did not overcome the objection raised under Article 83 EPC." This finding, however, is correct only to the extent that the medical apparatuses according to both claims 1 as filed and as amended comprise a case, a light source, a mirror, an optical filter, a shutter (obturator) disc provided with orifices (openings) and a slit regulating (adjusting) device. Besides these features, claim 1 as amended also recites the features that during operation ("by rotating the device (9)", i.e. the slit regulating device) slits are formed, which have determined shape and dimensions and control the modulation of light passing through them with regard to frequency and amplitude. These features can, however, be regarded as being implicitly defined by claim 1 as filed, if it is read in the light of the whole application, as it should be. Indeed, the skilled person would understand that the claimed rotating shutter disc and slit regulating device have the effect of modulating light passing through the orifices of the rotating shutter disk, which must be variable as implied by provision of the "slit regulating" device. Therefore, claim 1 filed with the letter of 19 March 2007 does not differ from claim 1 of the application as filed in such a way that the reasons for the raised objection under Article 83 EPC 1973 would substantially change.

In view of the foregoing, the circumstances of the present case are not comparable with those underlying T 734/91. In that case the appellant had filed a fresh set of claims in reply to a communication of the examining division, the subject-matter of claim 1 being

considerably changed in the light of the objection of lack of novelty raised by the examining division.

- 2.6 A further issue concerns the allegation that the examining division did not fully and accurately deal with all the relevant arguments submitted by the applicants in their reply of 19 March 2007. Provided that the reasons given enable the appellant and the Board to understand whether the decision was justified or not, the examining division is under no obligation to address each and every argument presented by the party concerned. In the present case, the examining division commented on the crucial points of dispute thus giving the applicants a fair idea of why their submissions were not considered convincing. This allegation is therefore also not conclusive.
- 2.7 In conclusion, the examining division did not commit a substantial procedural violation.
- 2.8 Pursuant to Article 11 RPBA a board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

In the present case, since no fundamental deficiencies are apparent in the proceedings before the examining division, the remittal of the case without any substantive examination is unjustified.

3. *Request for reimbursement of the appeal fee*

Pursuant to Rule 67 EPC 1973 the reimbursement of the appeal fee shall be ordered where the board deems the appeal to be allowable, if such reimbursement is equitable by reasons of a substantial procedural violation.

In the present case, since no substantial procedural violation is apparent in the proceedings before the examining division, the reimbursement of the appeal fee is not equitable and the request for reimbursement is refused.

4. *Article 83 EPC 1973*

- 4.1 At the oral proceedings the representative of the appellants submitted that the invention concerned a medical apparatus and that document WO-A-03/015868 (D2) represented the closest state of the art. With regard to this document, the claimed medical apparatus reflected the solution to the problem of improving the versatility of the known apparatus and, more specifically, of adjusting the light beam generated by the known apparatus. In particular, the solution consisted in the provision of the rotating shutter disc having orifices, the shape and size of which were varied by the regulating device placed between the rotating shutter disc and the light source. The application disclosed this general technical teaching as well as examples of features having an influence on the frequency and shape of the light pulses obtained at the output of the apparatus, in particular the rotating velocity of the shutter disc (application as filed,

page 10, last three lines), the shape of the orifices of the shutter disc (application as filed, page 5, lines 31-35) and the shape of the regulating device (application as filed, Figure 2). Therefore, the requirement of Article 83 EPC 1973 was met because the application disclosed all the information necessary for making the apparatus characterised by improved versatility with regard to the amplitude profile of the output light beam. Thereby, it was completely irrelevant whether or not the medical effect disclosed by the application (page 8, lines 20-22) concerning the improved penetration depth of light into a biological tissue was achieved.

- 4.2 According to Article 83 EPC 1973 the application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The EPC does not define the concept of the invention. An indirect definition may, however, be inferred from Article 52, paragraph 1, EPC defining the requirements to be met for the invention to be patentable. With regard to novelty and inventive step, the state of the art forms the basis for the assessment of an invention (Article 54, paragraph 1, EPC 1973 and Article 56 EPC 1973). A technical character of the invention results from the Implementing Regulations to the EPC. Thus, the description of the application shall specify the technical field to which the invention relates (Rule 27, paragraph 1, letter a, EPC 1973). The description shall also disclose the invention, as claimed, in such terms that the technical problem and its solution can be understood, and state any advantageous effects of the invention with reference to the background art (Rule 27, paragraph 1, letter c, EPC

1973). Moreover, the description shall describe in detail at least one way of carrying out the invention claimed (Rule 27, paragraph 1, letter e, EPC 1973). The technical character of the invention also results from (Rule 29, paragraph 1, EPC 1973) requiring that the claims shall define the matter for which protection is sought in terms of the technical features of the invention.

- 4.3 In the present case, relying on the approach derivable from Rule 27, paragraph 1, letters b and c, EPC 1973 the appellants regarded D2 as a background document useful for understanding the disclosed invention as claimed in terms of the technical problem and its solution.

D2 refers to an apparatus belonging to the class of medical devices for light therapy, of which another similar example is given by document WO-A-92/13597 (D1) acknowledged in the description of the present application as background art.

In particular, D2 (page 1, lines 1-4) discloses a medical apparatus for producing a light flux for biologic treatments. The apparatus (Figure 1) essentially comprises a case 3, in which a light source bulb 4, two rotating reflecting cylinders 8 and a concave mirror 7 are arranged, the concave mirror 7 being mounted on one wall of the case 3. An optical filter 14 and a lens objective 15 are mounted on the opposite wall of the case 1. A rotating shutter disc 10 comprising two orifices is mounted within the case 3 on the same wall as the optical filter 14 in such a way that the orifices become coaxial with the optical filter axis during rotation of the shutter disc 10. A

light flux is obtained that is made up of the rays reflected by the concave mirror 7 and of the direct rays emitted by the light source bulb 4 and reflected by the two rotating reflecting cylinders 8, the rays then passing through the orifices of the rotating shutter disc 10 to the lens objective 15.

An effect achieved by the apparatus according to D2 concerns the depth of penetration of light into biologic tissue, which depends on the wavelength of the light as it is commonly accepted in the art. Thus, depending on the application, the penetration depth can be controlled by the choice of the light source and the optical filter. The disclosure of D2 also alleges that the light beam modulation obtained by the rotating shutter disc has an influence on the light penetration depth. This allegation, however, is not supported by general skilled knowledge. The question of whether the light modulation indeed produces such an effect is not relevant for the present decision and, therefore, need not be gone into.

- 4.4 Starting from D2, a technical problem can be defined. As a general principle, the technical problem shall be formulated so that it is based on the technical effect(s) of exactly those features distinguishing the claim from the prior art and is as specific as possible without containing elements or pointers to the solution (T 1019/99 (unpublished); Reasons, point 3.3).

The apparatus of claim 1 essentially differs from that according to D2 in that the rotating shutter disc is equipped with a slit regulating device. As the expression "*slit regulating*" necessarily implies, the

orifices of the shutter disc are variable in shape and size depending on the mutual position of the rotating shutter disc and the slit regulating device. Thus, assuming that the shutter disc rotates at a given speed, the apparatus of D2 generates a single light amplitude profile, whereas the apparatus of the present invention permits to achieve a plurality of profiles owing to the variable orifices of the shutter disc. This difference confers the apparatus of the present invention a higher versatility, as submitted by the appellants. Different light modulations may be obtained with the apparatus of D2 but this would require that the case be opened and the shutter disc be replaced with another one having unlike orifices, this procedure being unpractical. According to the present invention, however, the drawback is avoided by the possibility of easily varying the mutual arrangement of the shutter device and the slit regulating device.

Therefore, starting from the apparatus of D2 the technical problem to be solved by the invention can indeed be seen in improving the versatility of the known apparatus and, more specifically, in enabling the amplitude profile of the light beam generated by the apparatus to be adjusted depending on the application. Such a formulation is based on the technical effect of the feature distinguishing the present claim 1 from D2. Moreover, it appears to be reasonably specific without containing elements or pointers to the solution.

- 4.5 The solution of claim 1 consists in the arrangement of the rotating shutter disc equipped with the slit regulating device. This represents the technical contribution of the invention to the state of the art

according to D2. The technical teaching is admittedly broad since it covers innumerable embodiments with regard to the rotating speed of the shutter disc, the size and shape of the orifices of the shutter disc, the shape of the slit regulating device, the size and shape of the orifices deriving from the combination of the shutter device and the slit regulating device. This broadness, however, is not prejudicial to the fact that the skilled person can carry out the invention, whereby the criteria according to which a given light modulation should be selected in relation to a desired application are irrelevant.

- 4.6 The appellants' understanding of the invention as presented at the oral proceedings raises the question whether it may represent an inadmissible shift of the invention. The application as filed describes an apparatus. This comprises among other structural features the rotating shutter disc provided with orifices and the slit regulating device that may have different shapes, an example of which is given by Figure 2. On the basis of those parts of the description which relate to these two elements, the skilled person will understand that the orifices are variable in shape and size with the effect that the modulation of light passing through these orifices will also vary. Thus, the appellant's presentation of the invention has a basis in the application as filed. With this understanding, the possible applications of the disclosed apparatus and the alleged effect of an improved depth of penetration of light into tissue due to the light modulation are completely irrelevant.

4.7 In the light of the foregoing, the application meets the requirements of Article 83 EPC 1973.

5. *Request for grant of a patent*

5.1 Both the communication of 20 November 2006 and the decision under appeal deal only with the objection under Article 83 EPC 1973. During the oral proceedings before the Board the appellants presented a way of understanding the invention that substantially differed from the interpretation considered in the examination procedure. The new understanding of the invention renders possible a complete examination of the case. Under these circumstances, although the EPC does not give an applicant the right to have each issue concerning its case to be considered in two instances, it appears equitable to remit the present case for further prosecution pursuant to Article 111, paragraph 1, second sentence, second alternative, EPC 1973. The examining division, therefore, will have to examine whether the application meets all the requirements of the EPC other than Article 83 EPC 1973. In this respect, it is noted that for consistency reasons the assessment of inventive step shall be based on the formulation of the technical problem as stated above, if the closest state of the art considered is represented by document D2. Moreover, those parts of the description which relate to the alleged effect of increased penetration depth of light need to be deleted.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of claims 1-8 filed at the oral proceedings on 9 July 2008.
3. The request for reimbursement of the appeal fee is refused.

The Registrar

The Chairman:

R. Schumacher

B. Schachenmann